

REMARKS

Claims 7, 8, 10 and 11 are presently pending. Claims 1,2, 4-8, 10, 11, 13, 14, 16, and 17 were rejected. Claims 1-6, 9, and 12-17 are cancelled without prejudice. Claim 7 is amended.

Claims 7, 8, 10, and 11 were rejected under 35 U.S.C. § 112. Assignee has amended claim 7, and it is submitted that claim 7 as now amended overcomes this rejection.

Claims 7 was rejected under 35 U.S.C. 103(a) as obvious from the combination of King in further view of Wallace, in further view of Fitzpatrick.

Examiner noted that "King et al fails to specifically disclose a decompression engine. ... a decompression is inherently present to perform the functionality of Wallace et al's disclosure since Wallace et al teaches the functionality of decompression scheme of MPEG-2.

Assignee respectfully submits that "a decompression engine for decompressing the compressed representation of the first frame and creating a graphic, said graphic displaying the at least one parameter" is not inherent in Wallace. "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the

thing described in the reference, and that it would be so recognized by persons of ordinary skill." MPEP 2112.

Assignee respectfully submits that there is no showing Wallace or King include a "a decompression engine for ... creating a graphic, said graphic displaying the at least one parameter".

Accordingly, Examiner is requested to withdraw the rejection to claims 7 and dependent claims 8, 9, 10 and 11.

For the foregoing reasons, each of the pending claims are allowable, making the application in a condition for allowance. Assignee respectfully requests that Examiner pass this case to issuance.

Additionally, it is believed that this correspondence is accompanied with the appropriate monies (either by check or authorization to charge deposit account) for the actions requested herein. To the extent that it is not, Commissioner is hereby authorized to charge or credit overpayment to account 13-0017, of any additional fees for the actions requested herein.

Respectfully submitted,



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